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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/490,038	01/24/00	TAKAHASHI	T US000034

EXAMINER

HM12/0827

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ART UNIT	PAPER NUMBER
1623	6

DATE MAILED: 08/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

1- File Copy

PTO-90C (Rev 2/95)

Office Action Summary

Application No.	Applicant(s)
09/490,038	Takahasi et al
Examiner	**Art Unit**
Oh Taylor Victor	1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jun 20, 2001*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above, claim(s) 8-10 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) 1-7 and 11 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Election/Restriction

I. Claims 1-7, drawn to a method of manufacturing carboxylic acid and amino acid, classified in class 562 , subclasses 400 and 553 .

II. Claims 8-10, drawn to a method for manufacturing surfactants comprising a mixture of carboxylic acids and amino acids, classified in class 562, subclass 561.

Applicants have elected without traverse Group I for prosecution in the application. Claims 8-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention , there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

Detailed Action

1. Claims 6 , 7 and 11 are objected to under 37 CFR 1.75(c) as being in improper form because claim 6, which is a multi-dependent claim, improperly depends from multi-dependent claims 7 and 11, which depend from claim 6 are also rejected as being based on an improper multi-dependent claim. These improper multi-dependent claims will be examined in so far as the Examiner can determine that which applicants intend, in spite of improper multiple dependence.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 , 3-4, and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by van Pottelsberghe dela Potterie (U.S. 3,716,380).

van Pottelsberghe dela Potterie discloses a method of making flavoring substances by reacting a protein hydrolysate, palmitic acid, methionine, lactic acid , water, and etc. at a temperature of 100^0 C. (See col. 3 , Example 2). This is identical with the claims.

3. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated clearly by Madsen et al (U.S. 5,189,016).

Madsen et al disclose a glutaminyl-glycine dipeptide having a N-terminal amino acid as shown in the specification (see col. 4 , lines 12-25). This is identical with the claim.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heins et al (U.S. 4,032,676).

Heins et al teach a method of making N-polyhydroxyalkylamino acids by reacting uronic acids in alcohols, ethers or their mixtures with water in the presence of amino acids at a temperature between 50^0 to 100^0 C.(See col. 3 ,lines 58-65).

However, Heins et al differ from the instant invention in that the heating is carried out at 105^0 or more.

Concerning the heating carried out at 105^0 or more, the claimed ranges and prior art do not overlap, but are close enough that one skilled in the art would have expected them to have a similar reaction condition in the absence of unexpected results. Furthermore, the limitation of a process with respect to ranges of pH, time and temperature does not impart patentability to a process when such values are those which would be determined by one of ordinary skill in the art in achieving optimum operation of the process. Temperature is well understood by those of ordinary skill in the art to be a result-effective variable especially when attempting to control selectivity of a chemical process.

Therefore, if the skillful artisan in the art had desired to control selectivity of a chemical process related to the manufacturing carboxylic acids and amino acid condensates, it would have been obvious for the skillful artisan in the art to have obtained the optimum temperature range for the process by routine experimentations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Victor Oh whose telephone number is (703) 305-0809. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist , can be reached on (703) 308-1701. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

8/25/01

JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600